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Paper No.

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ROCKVILLE MD 20850

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**JAN 09 2007**

**OFFICE OF PETITIONS**

In re Application of :  
Gentz et al. : DECISION ON APPLICATION  
Application No. 09/518,931 : FOR  
Filed: March 3, 2000 : PATENT TERM ADJUSTMENT  
Atty Docket No. PF454P1 :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b) AND REQUEST TO AMEND ENTRIES IN PAIR" filed October 11, 2006. Applicants disclose that the initial determination of patent term adjustment under 35 U.S.C. 154(b) is one thousand twenty (1020) days and not one thousand two hundred twenty-six (1226) days.

The application for patent term adjustment is GRANTED to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is five hundred ninety-nine (599) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On July 12, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment<sup>1</sup> (PTA) to date is 1226 days. On October 11, 2006, applicants timely submitted an application for patent term adjustment (with required fee)<sup>2</sup>. Applicants indicate that both the period of

<sup>1</sup> This application became eligible for patent term adjustment for examination delay by virtue of the filing of a continuing prosecution application on October 25, 2000.

<sup>2</sup> PALM records indicate that the Issue Fee payment was also received on October 11, 2006.

adjustment of 1146 for Office delay in responding to applicants' reply and the period of adjustment of 206 days for Office delay due to an interference delay should not be entered. Applicants assert that the period of adjustment of 206 days should be corrected to 0 days because the period of 206 days extending from July 17, 2003 until February 8, 2004, overlaps entirely with the period calculated for the 1146-day Office delay.

The record supports a conclusion that the present application is not subject to a terminal disclaimer

Applicants are correct that if the periods of adjustment did so overlap that both periods should not be entered in the application. However, in this instance, a review of the periods of adjustment reveals that the period of adjustment of 1146 days for Office delay is incorrect.

Pursuant to 37 C.F.R. § 1.702(a),

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

... (2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

On January 17, 2002, the Office mailed the Letter Regarding Suspension in response to, and within four months of, applicants' filing of the amendment after final on November 20, 2001. Thus, there was no examination delay within the meaning of § 1.702(a)(2). Thus, the period of adjustment of 1146 days for Office delay in responding to the amendment filed November 20, 2001 has been corrected to 0 days.

With respect to the periods of delay associated with the interference proceeding, 37 CFR 1.702(c) provides that:

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to interference proceedings under 35 U.S.C. 135(a).

Further, 37 CFR 1.703(c) provides that:

The period of adjustment under § 1.702(c) is the sum of the following periods, to the extent that the periods are not overlapping:

(1) The number of days, if any, in the period beginning on the date an interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(2) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

A review of the record reveals that letters of suspension were mailed on January 17, 2002, July 17, 2003 and June 9, 2004 due to an interference in another application. The record supports a conclusion that actions closing the A/R record and resetting the status with respect to these suspensions were taken on November 18, 2002, February 8, 2004, and January 8, 2005 respectively.

Applicants are entitled to periods of adjustment for examination delay pursuant to 1.702(c) only for those periods during which issuance of the patent was delayed due to interference proceedings under 35 U.S.C. 135(a). In this instance, pursuant to 1.703(c)(2), such period is limited to the number of days in the period beginning on the date prosecution in the application was suspended by the Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension. With respect to the suspensions in this case, it is concluded that the periods of adjustment are properly 306 days for the period from January 16, 2002 to November 18, 2002, 206 days for the period from July 17, 2003 to February 8, 2004, and 213 days for the period from June 9, 2004 to January 8, 2005. Thus, the total period of adjustment pursuant to 1.702(c) is 725 days.

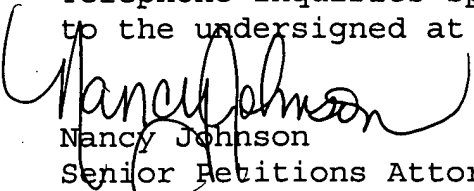
In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is five hundred ninety-nine (599) days (213 + 206 + 306 days of Office delay - an undisputed 126 days of applicant delay).

As this letter was submitted as an attempt to advise the Office of an error in Applicants' favor, the Office will not assess the \$200.00 fee under 37 CFR 1.18(e). The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office.

The Office of Patent Publication has been advised of this decision. The Office has, thereby, forwarded the file to the Office of Patent Publication so that a patent can be issued. The patent term adjustment indicated on the patent will include any additional patent term accrued for Office delay in issuing the patent after the issue fee had been paid and all outstanding requirements met.

Petitioner is reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

  
Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Enclosed: Copy of REVISED PALM Screen

## PTA Calculations for Application: 09/518931

Application Filing Date:	03/03/2000	PTO Delay (PTO):	1352
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	126
Post-Issue Petitions:	0	Total PTA (days):	599
PTO Delay Adjustment:	-627		

## File Contents History

Number	Date	Contents Description	PTO	APPL	START
89	01/08/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	213		
88	01/08/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	206		
87	01/08/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	306		
86	01/08/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		1146	
85	01/08/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		206	
75	07/12/2006	MAIL NOTICE OF ALLOWANCE			
74	07/12/2006	MAIL EXAMINER'S AMENDMENT			
73	07/10/2006	ISSUE REVISION COMPLETED			
72	07/10/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
71	07/10/2006	EXAMINER'S AMENDMENT COMMUNICATION			
70	07/10/2006	NOTICE OF ALLOWABILITY			
69	04/25/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
68	04/25/2006	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
67	04/25/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	65
66	05/03/2006	DATE FORWARDED TO EXAMINER			
65	04/25/2006	RESPONSE AFTER NON-FINAL ACTION		1	62
64	04/25/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
63	03/18/2006	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
62	01/24/2006	MAIL NON-FINAL REJECTION			
61	01/23/2006	NON-FINAL REJECTION			
60	10/11/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			

59	11/17/2005	DATE FORWARDED TO EXAMINER			
58	11/08/2005	RESPONSE AFTER NON-FINAL ACTION		28	53
57	10/21/2005	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
56	10/11/2005	REFERENCE CAPTURE ON IDS			
55	10/11/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
54	10/19/2005	DATE FORWARDED TO EXAMINER			
53.1	10/11/2005	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
53	10/11/2005	RESPONSE AFTER NON-FINAL ACTION		63	51
52	10/11/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
51	05/09/2005	MAIL NON-FINAL REJECTION	1146		35
50	05/03/2005	NON-FINAL REJECTION			
49	01/08/2005	DATE FORWARDED TO EXAMINER			
48	01/08/2005	TO CLOSE THE A/R RECORD AND RESET THE STATUS FOR EXPIRED SUSPENSIONS.			
47	12/09/2004	MISCELLANEOUS INCOMING LETTER			
46	06/09/2004	MAIL LETTER OF SUSPENSION			
45	06/08/2004	LETTER OF SUSPENSION - EXAMINER INITIATED			
44	02/08/2004	DATE FORWARDED TO EXAMINER			
43	02/08/2004	TO CLOSE THE A/R RECORD AND RESET THE STATUS FOR EXPIRED SUSPENSIONS.	206		42
42	07/17/2003	MAIL SUSPENSION DUE TO INTERFERENCE IN ANOTHER APPLICATION			
41	07/17/2003	LETTER OF SUSPENSION - INTERFERENCE IN ANOTHER CASE			
40	11/18/2002	DATE FORWARDED TO EXAMINER			
39	11/18/2002	TO CLOSE THE A/R RECORD AND RESET THE STATUS FOR EXPIRED SUSPENSIONS.			
38	01/17/2002	MAIL LETTER SUSPENDING PROSECUTION AT APPLICANT'S REQUEST			
37	01/16/2002	LETTER OF SUSPENSION - APPLICANT INITIATED			
36	12/10/2001	DATE FORWARDED TO EXAMINER			
35	11/20/2001	AMENDMENT AFTER FINAL REJECTION		34	31
34	11/20/2001	REQUEST FOR EXTENSION OF TIME - GRANTED			

33	11/20/2001	REQUEST FOR EXTENSION OF TIME - GRANTED			
32	10/12/2001	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
31	07/17/2001	MAIL FINAL REJECTION (PTOL - 326)			
30	07/16/2001	FINAL REJECTION			
29	05/14/2001	DATE FORWARDED TO EXAMINER			
28	05/04/2001	RESPONSE AFTER NON-FINAL ACTION			
27	05/04/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
26	02/27/2001	MAIL NON-FINAL REJECTION			
25	02/26/2001	NON-FINAL REJECTION			
24	01/22/2001	CASE DOCKETED TO EXAMINER IN GAU			
23	01/03/2001	DATE FORWARDED TO EXAMINER			
22	12/12/2000	RESPONSE TO ELECTION / RESTRICTION FILED			
21	12/12/2000	REQUEST FOR EXTENSION OF TIME - GRANTED			
20	12/12/2000	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
19	11/20/2000	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
18	11/09/2000	MAIL RESTRICTION REQUIREMENT			
17	11/09/2000	REQUIREMENT FOR RESTRICTION / ELECTION			
16	11/09/2000	DATE FORWARDED TO EXAMINER			
15	10/25/2000	CONTINUING PROSECUTION APPLICATION - CONTINUATION (ACPA)			
14	10/25/2000	MAIL EXPRESS ABANDONMENT (DURING EXAMINATION)			
13	10/25/2000	EXPRESS ABANDONMENT (DURING EXAMINATION)			
12	10/25/2000	PRELIMINARY AMENDMENT			
11	10/25/2000	NEW OR ADDITIONAL DRAWING FILED			
10	10/25/2000	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	10/25/2000	WORKFLOW - REQUEST FOR CPA - BEGIN			

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**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**